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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,189	07/31/2003	Claudia A. Iannotti	10021017-1	1422

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AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

EXAMINER

CROW, ROBERT THOMAS

ART UNIT	PAPER NUMBER
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1634

MAIL DATE	DELIVERY MODE
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12/22/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/631,189	Applicant(s) IANNOTTI ET AL.	
	Examiner Robert T. Crow	Art Unit 1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____
 Claim(s) objected to: _____
 Claim(s) rejected: 1-37.
 Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____

Continuation of 3. NOTE: The amendments filed 5 November 2003 further limit the method to include a lysate that contains genomic DNA, the binding of the genomic DNA to a filter material, and the binding of the isolated nucleic acids to silicon carbide. These new limitation narrow the scope of the claim, and therefore require further search and consideration. None of the previous claims required genomic DNA in the lysate, the binding of genomic DNA to the filter material, or the binding of the isolated nucleic acids to the silicon carbide. Thus, further search and consideration would be required.

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection of claim 1 and 7-9 over copending Application No. 10/914,920 in view of Haj-Ahmad are withdrawn in view of Applicant's filing of a Terminal Disclaimer. The Terminal Disclaimer was approved on 12 December 2006.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues on pages 5-6 and pages 7-8 of the Remarks that the references do not teach or suggest collecting the effluent from the column for further purification via a second column.

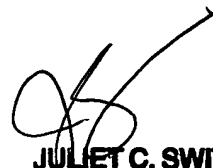
However, as noted in the previous Office Action, Avjioglu et al explicitly teach the nucleic acids recovered from the first spun column are subjected to a second round of spun column chromatography to further increase the proportion of the desired nucleic acid to over 90% of the sample (column 15, lines 5-10).

Applicant further argues on pages 6 and 8 of the Remarks that the combined references do not teach purification on a silicon carbide whisker column.

However, as noted in the previous Office Action, the specification does not define what is encompassed by the term "whisker." The term "whisker" has therefore been interpreted to be encompassed by the preferred embodiment of Haj-Ahmad, wherein the silicon carbide particles have an average particle size of 4.5 microns (column 4, lines 1-3). Thus, the claim has been given the broadest reasonable interpretation consistent with the specification.

In addition, as noted in the previous Office Action, the courts have held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. In the event that the instantly claimed "whiskers" are not encompassed by the micron sized particles of Haj-Ahmad, the instantly claimed "whiskers" would therefore merely be a form of silicon carbide having different relative dimensions than those of the prior art, and as such are not patentably distinct from the particles of Haj-Ahmad.

Applicant's remaining arguments refer the amended claims and rely on the amendments. Since the amendments were not entered, the arguments are moot. The rejections are therefore maintained.



JULIET C. SWITZER
PRIMARY EXAMINER